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EXAMINER

ALIE, GHASSEM

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FABIO PERINI

Appeal 2009-008646
Application 10/524,001
Technology Center 3700

Decided: March 19, 2010

Before JENNIFER D. BAHR, JOHN C. KERINS, and STEVEN D.A.
McCARTHY, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Fabio Perini (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1, 3-6, 25 and 26. Claims 12-24 have been withdrawn from consideration, and claims 2 and 7-11 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

An oral hearing was conducted on March 16, 2010, with Brian M. Duncan, Esq., appearing on behalf of Appellant.

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

Appellant's claimed invention is to an apparatus for producing small paper rolls having a rewinding machine, a trimming device, a trimmed roll store element, and a cutting-off machine. Independent claim 1 is reproduced below, and is illustrative of the overall claimed subject matter:

1. An apparatus for producing small paper rolls,
the apparatus comprising:

a rewinding machine, said rewinding machine
producing elongated paper rolls;

a trimming device, said trimming device trimming
at least one end of each roll produced by said
rewinding machine to form trimmed rolls;

a trimmed roll store element, said trimmed roll
store element receiving said trimmed rolls from
said trimming device, said trimmed roll store
element storing the trimmed rolls;

a cutting-off machine, said trimmed roll store element supplying said trimmed rolls to said cutting-off machine, said cutting-off machine subdividing the trimmed rolls into a plurality of small rolls.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Friden	US 2,047,021	Jul. 7, 1936
Nystrand	US 3,905,260	Sep. 16, 1975
Gambaro	US 2002/0121170 A1	Sep. 5, 2002

The Examiner has rejected:

- (i) claims 1, 3-6, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Gambaro in view of Nystrand and Friden; and
- (ii) claims 1, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Nystrand in view of Friden.

ISSUES

Did the Examiner err in concluding that it would have been obvious, in view of the combined teachings of Gambaro, Nystrand and Friden, to modify the Gambaro apparatus to include a rewinder and a trimming device in order to produce elongated rolls and supply them to a cutting station in the same apparatus, and in order to trim the ends of the rolls prior to the step of subdividing the rolls into a plurality of smaller rolls?

Did the Examiner err in concluding that it would have been obvious, in view of the combined teachings of Nystrand and Friden, to modify the Nystrand apparatus to include a trimming device in order to trim the ends of the rolls and eliminate uneven or rough edges on the rolls?

PRINCIPLES OF LAW

A rejection on obviousness grounds based upon a combination of elements individually known in the prior art is proper only if there is an apparent reason to combine the known elements in the fashion claimed. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Such a rejection cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co.*, 550 U.S. at 418.

ANALYSIS

Claims 1, 3-6, 25 and 26--Obviousness--Gambaro/Nystrand/Friden

Claims 3-6, 25 and 26 all depend from independent claim 1. Appellant presents arguments for each of the claims under separate headings in the Appeal Brief. Claim 1 will first be addressed.

The Examiner found that the Gambaro patent discloses an apparatus for producing small paper rolls including a store element for receiving and storing rolls, and for supplying the rolls to a cutting-off machine, the cutting-off machine operating to subdivide the rolls into a plurality of small rolls. (Answer 3). The Examiner noted that Gambaro fails to explicitly teach the provision of a rewinding machine for producing elongated paper rolls. The Examiner, citing to the paper roll-producing apparatus of Nystrand, concluded that it would have been obvious to provide a rewinding machine

on the Gambaro apparatus in order to produce rolls and supply them to a cutting station in the same apparatus. (*Id.*). The Examiner further noted that the Gambaro/Nystrand combination does not teach the provision of a trimming device. The Examiner here cited to the trimmer disclosed in Friden for trimming the irregular ends of tubular elements, and concluded that it would have been obvious to provide the Gambaro apparatus with a trimming device in order to trim the ends of the paper rolls to eliminate uneven or rough end edges prior to the step of subdividing the rolls into a plurality of rolls. (Answer 3-4).

Appellant goes to considerable lengths in attacking the teachings of the Gambaro, Nystrand and Friden references individually. (Appeal Br., *passim*; Reply Br., *passim*). The rejection is, however, based on a combination of teachings of the references as a whole, and, as such, those arguments are not probative of the existence of error in the rejection of claim 1 as being obvious. *See In re Keller*, 642 F.2d 413 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986) (nonobviousness can not be established by attacking references individually where rejections are based on combinations of references).

Appellant further argues that persons of ordinary skill in the art would not look to combine the teachings of Friden with those of Gambaro to include a separate trimming device, because Gambaro itself discloses a cutting machine that provides for both cutting and trimming of paper logs. (Appeal Br. 10). Gambaro does disclose that, in the preferred operation of that apparatus, “a relatively small portion of the substrate log is cut from each end of the log by the outermost saw blades”. (Gambaro, p. 3, para. [0054]). This cutting of one or both ends of the log is essentially what is

done by Appellant, albeit in Appellant's claimed apparatus, the trimming device is a separate element from the cutting-off machine.

While the Examiner's stated reason to combine the teachings of Friden with Gambaro was for the purpose of providing a trimming of the ends of the logs prior to the step of subdividing the logs into a plurality of rolls (Answer 4), the Examiner has not asserted that there is any particular benefit or advantage to performing the trimming prior to subdividing, as contrasted to Gambaro's contemporaneous trimming and subdividing. This is particularly significant in that the proposed combination involves providing additional equipment at the additional cost of such equipment, and the likely attendant increase in factory space taken up by the additional equipment, with the result that no additional or different function would be performed by the modified Gambaro apparatus than is performed by the Gambaro apparatus as disclosed.

The evidence and arguments of Appellant and the Examiner leads us to conclude that the Examiner has not presented a persuasive reason to have combined the teachings of Friden with those of Gambaro, or with those of the combination of Gambaro and Nystrand, and thus the conclusion that claim 1 would have been obvious in view of the combined teachings of the three references can not be sustained. The rejection will also not be sustained with respect to claims 3-6, 25 and 26, which all depend from claim 1.

Claims 1, 25 and 26--Obviousness--Nystrand/Friden

The Examiner found that the Nystrand patent discloses a rewinding machine, a roll store element, and a cutting off machine as called for in claim 1. The Examiner concluded that it would have been obvious, in view

of the disclosure of a trimmer in Friden, to modify the Nystrand device to include a trimming device, in order to trim the ends of the rolls and eliminate uneven or rough edges on the rolls. (Answer 5-6).

Like the Gambaro apparatus discussed above, the Nystrand apparatus employs a log saw to not only cut or subdivide a paper log into a plurality of log rolls, but also to trim one or both ends of the log, producing thin trim rolls or “cookies”, which are then disposed of. (Nystrand, col. 5, ll. 8-25). As was the case with Gambaro and Friden above, the proposed combination of Nystrand and Friden involves providing additional equipment at the additional cost of such equipment, and the likely attendant increase in factory space taken up by the additional equipment, with the result that no apparent additional or different function would be performed by the modified Nystrand apparatus than is performed by the Nystrand apparatus as disclosed.

We again do not see a persuasive reason for a person of ordinary skill in the art to have combined the teachings of Friden with those of Nystrand, and thus the conclusion that claim 1 would have been obvious in view of the combined teachings of these two references can not be sustained. The rejection will also not be sustained with respect to claims 25 and 26, which depend from claim 1.

CONCLUSIONS

The Examiner erred in rejecting claims 1, 3-6, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Gambaro, Nystrand and Friden; and in rejecting claims 1, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Nystrand and Friden.

Appeal 2009-008646
Application 10/524,001

DECISION

The decision of the Examiner to reject claims 1, 3-6, 25 and 26 is reversed.

REVERSED

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